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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,764	02/07/2002	Koon Ha Park	LNK-0005	1624

7590 10/13/2005

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EXAMINER
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KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/071,764

Applicant(s)

PARK ET AL.

Examiner

Timothy J. Kugel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-13 are pending as amended on 4 August 2005.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Information Disclosure Statement***

3. US 4,882,254 (Loutfy hereinafter) was referred to in applicant's argument but has not been made of record on an Information Disclosure Statement. For applicant's convenience, Loutfy has been cited by the examiner on form PTO-892.

#### ***Claim Rejections - 35 USC § 103***

4. The rejection of claims 1-13 under 35 USC 103(a) as being unpatentable over Van Moer as evidenced by Bollyky in view of Seybold is maintained. Applicant's arguments filed 4 August 2005 have been fully considered but they are not persuasive.

Applicant argues that Van Moer teaches a composition emitting blue chemiluminescent light rather than the claimed red light, directing attention to the Abstract; However, the abstract of Van Moer is silent as to the color of light emitted, but does indeed teach the emission of red light (Column 1 Lines 33-63 and Claim 14).

Applicant further argues that Van Moer teaches the use of a solvent or oxalate, directing attention to Column 4 Line 28; However Column 4 Line 28 is silent to the use of an oxalate. Column 3 Line 47 uses the phrase 'solvent or oxalate', but that paragraph merely teaches that any known solvent or oxalate can be used to produce chemiluminescent light, not that a solvent and oxalate cannot be used in combination; further Van Moer clearly teaches that the perylene, solvent and oxalate are used in

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combination (Column 3 Lines 63-66, Examples 1-13 Column 4 Line 19 – Column 5 Line 38).

Applicant further argues that Van Moer doesn't teach the perylene compound claimed. This is so, as the teaching of the specific perylene is from Seybold. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that there is no motivation to combine Bollyky's teaching of peroxide catalysts with the teachings of Van Moer; However, Bollyky's teachings were incorporated by reference into Van Moer (Column 3 Lines 66 and 67) and were treated as such.

Applicant argues that there is a lack of motivation to combine the teachings of Seybold with the teachings of Van Moer. Applicant alleges that the previous Office action contended that the motivation to combine the perylene compound of Seybold in the composition of Van Moer was that the perylene compounds of Seybold are readily soluble in *all* organic solvents (emphasis added) and that this contention is refuted by Loutfy's showing that there exist some organic solvents that are non-solvents for perylene compounds. Applicant is directed to the last paragraph of Section 4 of the previous Office action, where the motivation to combine the perylene compound of Seybold in the composition of Van Moer is clearly stated as "its ready solubility in

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organic solvents" not in *all* organic solvents. Applicant is also directed to Seybold Column 7 Line 37, which makes the same statement.

Applicant finally argues that the perylene composition of Seybold is not as effective as those exemplified by applicant in producing chemiluminescent light; However since Van Moer and Seybold combine to teach the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the effectiveness of the combined composition in producing chemiluminescent light would inherently be the same as claimed. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. The rejection of claims 1-13 under 35 USC 103(a) as being unpatentable over Smithey in view of Seybold is maintained. Applicant's arguments filed 4 August 2005 have been fully considered but they are not persuasive.

Applicant argues that there is a lack of motivation to combine the teachings of Seybold with the teachings of Smithey as Smithey exemplifies diluents that Loutfy shows are non-solvents for perylene compounds, directing attention to Column 3 Lines 22-32; however, that paragraph describes potential diluents to the peroxide catalyst, not the perylene compound as taught by Seybold and besides, if Smithey did teach solvents in which the fluorescer was poorly soluble the motivation to combine Seybold's perylene compound with Smithey's composition would be strengthened.

Applicant finally argues that the perylene composition of Seybold is not as effective as those exemplified by applicant in producing chemiluminescent light as above; However since Smithey and Seybold combine to teach the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the effectiveness of the combined composition in producing chemiluminescent light would inherently be the same as claimed. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. The rejection of claims 1-13 under 35 USC 103(a) as being unpatentable over Chopdekar '517 in view of Seybold is maintained. Applicant's arguments filed 4 August 2005 have been fully considered but they are not persuasive.

Applicant argues that the perylene composition of Seybold is not as effective as those exemplified by applicant in producing chemiluminescent light as above; However since Chopdekar '517 and Seybold combine to teach the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the effectiveness of the combined composition in producing chemiluminescent light would inherently be the same as claimed. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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7. The rejection of claims 1-4, 6-9 and 11-13 under 35 USC 103(a) as being unpatentable over Chopdekar '103 in view of Seybold is maintained. Applicant's arguments filed 4 August 2005 have been fully considered but they are not persuasive.

Applicant argues that the perylene composition of Seybold is not as effective as those exemplified by applicant in producing chemiluminescent light as above; However since Chopdekar '103 and Seybold combine to teach the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the effectiveness of the combined composition in producing chemiluminescent light would inherently be the same as claimed. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### **Conclusion**

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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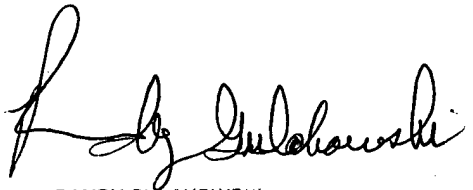
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK  
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